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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,684	02/06/2004	Paul A. Lotke	4323-P03363US0	7807
110 7590 03/18/2008 DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307				
EXAMINER SNOW, BRUCE EDWARD				
ART UNIT		PAPER NUMBER		
3738				
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03/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/773,684

**Applicant(s)**

LOTKE, PAUL A.

**Examiner**

Bruce E. Snow

**Art Unit**

3738

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 14-24, 50-76 and 78-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 14-24, 50-76 and 78-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The non-final Office action dated 12/26/07 has been withdrawn, a new action follows.

#### ***Response to Arguments***

Applicant's arguments filed 7/17/07 have been fully considered. It is noted that the claim numbering skips claim 65; please cancel said claim.

Regarding the rejection of claims 95-99 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, applicant noted that original claim 3 supports the claims; the rejection has been withdrawn.

Regarding the rejection under 35 U.S.C. 102(e) as being anticipated by Merchant (6,616,696), applicant has amended claim 78 reciting "the second portion has a length and a width and the length is greater than the width" which fails to overcome the rejection. Claim 78 uses the language first portion and second portion which can be arbitrarily chosen because they are only portions. Therefore, the second portion can be chosen to meet this language. Additionally, "a width" can be taken at any point along the second portion including the nearest distal point. "A width" does not have to be the maximum width just any width.

Regarding the rejection of claims 1-3, 5, 14-24, 50-99 (all claims) under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious Aram et al (2006/0058884), applicant now claims priority to the same provisional application as Aram et al which overcomes said rejection.

Regarding the rejection under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aubaniac, referring to figure 21, the body portion (trochlear portion) ends at the intercondylar notch (concave element) which is clearly shown at the bottom. Portion of elements 7 and 8 extend past the notch forming two points (extensions) that are interpreted as extending along the lateral edge of the notch without covering the when the prosthesis is implanted in a patient. Regarding claims 14, 50, 78 and 84, the extensions have a distal end which is a point. "A width" can be taken at any point along the extension including the adjacent the distal point.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 78, 81-83 are rejected under 35 U.S.C. 102(e) as being anticipated by Merchant (6,616,696).

Referring to figure 4, Merchant teaches a femoral prosthesis 130 comprising a first portion (upper portion) having a posterior surface configured to overlie a portion of a trochlear groove and an anterior surface forming a groove cooperable with a patella;

a second portion (lower portion) connected with the first portion, wherein the second portion is configured to overlie a portion of the intercondylar notch forming a surface cooperable with the patella;

wherein the second portion is configured so that the prosthesis has a terminal edge along the intercondylar notch.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 14-24, 50-76, 78-98 (all claims) are rejected under 35

U.S.C. 102(b) as being clearly anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious Keller (DE 29 01 099 A1).

Referring to all figures, specifically figure 3, Keller teaches:

78. (Currently Amended) A femoral prosthesis 17, comprising:

a first portion 18, 19 having a posterior surface configured to overlie a portion of a trochlear groove and an anterior surface forming a groove cooperable with a patella;

a second portion (generally 24) connected with the first portion, wherein the second portion is configured to overlie a portion of the intercondylar notch forming a surface cooperable with the patella;

wherein the second portion is configured so that the prosthesis has a terminal edge along the intercondylar notch:

and wherein the second portion has a length and a width and the length is greater than the width.

**Regarding at least claims 1, 14, 59, under 35 U.S.C. 103(a) when a patellar prosthesis is positively claimed:** It is unclear if Keller teaches a patellar prosthesis, however, it is well known in the art to use a patellar prosthesis of a different material with a femoral prosthesis. It would have been obvious to one having ordinary skill in the art to use a patellar prosthesis in combination with the femoral prosthesis of Keller when

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deemed necessary by the surgeon to repair the knee joint with a damaged or diseased patella with predictable results.

Regarding claim 1, the first and second wings (second portion) taper as shown in figure 6. The prosthesis is viewed as being saddle-shaped.

Regarding at least claim 55 requiring a condyle prosthesis, see generally elements 12.

Regarding at least claim 58 requiring a narrow waist, see figure 3, the narrowing convex portion just below element 17.

Claims 14-16, 18-24, 50-58, 78-94 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aubaniac (WO 87/02882, applicant submitted on IDS dated 8/01/06).

Aubaniac teaches various embodiments, referring to all figures, specifically figures 21-24, Aubaniac teaches:

*84. (New) A knee prosthesis for covering a portion of a patient's (patella), and trochlear groove and intercondylar notch of the femur, comprising:*

*(a patellar prosthesis configured to cover a posterior surface of a patella), and a femoral prosthesis comprising:*

*a body 1 having a posterior surface configured to cover a portion of the trochlear groove and an anterior surface forming a groove that is cooperable with the posterior surface of the patellar prosthesis;*

*a medial extension (8 or 9) projecting away from a distal end of the body configured to extend along a medial edge of the intercondylar notch; and*

*a lateral extension (the other of 8 or 9) projecting away from a distal end of the body configured to extend along a lateral edge of the intercondylar notch;*

*(regarding at least claim 84, Aubaniac teaches) a separate condyle prosthesis (2 or 3) configured to cover an articular surface of a condyle, wherein the condyle prosthesis has an inner edge configured to cooperate with an outer edge of the either the medial or lateral extension.*

**In the alternative, under 35 U.S.C. 103(a):** It is unclear if Aubaniac teaches a patellar prosthesis. It would have been obvious to one having ordinary skill in the art to use any patellar prosthesis known in the art in combination with the femoral prosthesis of Aubaniac when deemed necessary by the surgeon to repair the knee joint with a damaged or disease patella.

Referring to figure 21, the body portion (trochlear portion) ends at the intercondylar notch (concave element) which is clearly shown at the bottom. Portion of elements 7 and 8 extend past the notch forming two points (extensions) that are interpreted as extending along the lateral edge of the notch without covering the when the prosthesis is implanted in a patient. Regarding claims 14, 50, 78 and 84, the extensions have a distal end which is a point. "A width" can be taken at any point along the extension including the adjacent the distal point which meets the claim limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bes

/Bruce E Snow/  
Primary Examiner, Art Unit 3738